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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

YANG, CLARA I

ART UNIT

PAPER NUMBER

2612

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/26/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/716,308

Applicant(s)

YOSHIKAWA, FUMITAKA

Examiner

Clara Yang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ✓
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08) ✓
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

2. Claims 1, 5-8, and 11-13 are objected to because of the following informalities:
 - Claim 1: The claim limitations employ the phrases "for automatically performing mutual communication with the portable device and controlling a predetermined driver in accordance with whether mutual communication with the portable device is established," "for selecting one of a disablement mode...and a communication mode," "for recognizing which one of the disablement mode and the communication mode the portable device is in to determine whether to enable or disable automatic communication with respect to the portable device in accordance with the recognition," and "for providing the determination unit with recognition information used to recognize which one of the disablement mode and the communication mode the portable device is in." It has been held that the recitation that an element is "for" performing a function is not a positive limitation but only requires the ability to so perform.
 - Claims 5 and 12: The claim limitations employ the phrase "for receiving a signal from the communication controller". It has been held that the recitation that an element is "for" performing a function is not a positive limitation but only requires the ability to so perform.
 - Claims 6 and 13: The claim limitations employ the phrase "for transmitting a signal to the communication controller". It has been held that the recitation that an element is "for" performing a function is not a positive limitation but only requires the ability to so perform.
 - Claim 7: The claim limitations employ the phrases "for generating a notice that the portable device is in the disablement mode" and "for generating a notice that the portable device has shifted from the disablement mode to the communication mode." It has been held that the recitation that an element is "for" performing a function is not a positive limitation but only requires the ability to so perform.
 - Claim 8: The claim limitations employ the phrase "for locking and unlocking a door." It has been held that the recitation that an element is "for" performing a function is not a positive limitation but only requires the ability to so perform.

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- Claim 11: The claim limitations employ the phrases "for disabling automatic communication of the portable device relative to the communication controller" and "for enabling automatic communication of the portable device". It has been held that the recitation that an element is "for" performing a function is not a positive limitation but only requires the ability to so perform.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 6, and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Coppersmith (US 5,796,827).

Referring to claim 1, Coppersmith's Fig. 1 is a drawing of a typical environment in which a personal area network (PAN) is used, wherein other environments include entry through building or vehicle doors (see Col. 7, lines 59-66). Coppersmith's PAN (i.e., a communication system), as shown in Figs. 1 and 3, comprises (a) personal area network (PAN) card 5 (i.e., a portable device) having a communication function (see Col. 8, lines 3-6 and 20-22); (b) automated teller machine (ATM) 4 (hereinafter referred to as "communication controller 4") that automatically performs mutual communication with PAN card 5 and controls a door lock driver when the PAN is used to enter building doors (see Col. 7, lines 59-66; Col. 8, lines 3-6, 20-

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22, and 66-67; Col. 9, lines 1-24; and Col. 12, lines 1-5 and 21-33); (c) wake-up transmitter circuit 28 and wake-up receiver circuit 30 (i.e., selection devices) that selects one of a disablement mode and a communication mode (see Col. 9, lines 1-24); (d) microprocessor 32 that recognizes which one of the disablement mode and communication mode PAN card 5 is in and enables automatic communication with communication controller 4 when wake-up receiver circuit 30 fully powers PAN card 5 or disables communication with communication controller 4 while PAN card 5 is in an idle mode (i.e., disablement mode) (see Col. 9, lines 1-24); and (e) wake-up transmitter circuit 28 having a recognition information providing device that provides microprocessor 32 with information that a wake-up signal has been received (i.e., recognition information used to recognize that PAN card 5 is now in the communication mode) (see Col. 9, lines 1-24).

Regarding claim 2, as explained in the previous rejection of claim 1, Coppersmith's PAN card 5 has wake-up transmitter circuit 28, which functions as a selection device and a recognition information providing device.

Regarding claim 6, as shown in Fig. 3, Coppersmith's PAN card 5 includes transmitter electrodes 16 (i.e., a transmitting circuit) that transmits a signal to communication controller 4 and is deactivated when PAN card 5 is idle (i.e., in the disablement mode) (see Col. 9, lines 1-24).

Regarding claims 8-10, as explained in the previous rejection of claim 1, Coppersmith's personal area network (PAN) is suited for unlocking building or vehicle doors (see Col. 7, lines 59-66; Col. 11, lines 65-67; Col. 12, lines 1-5 and 21-33; and Col. 16, lines 8-14); thus Coppersmith's predetermined driver is a door lock driver (as called for in claim 8) that locks and unlocks the door of a vehicle (as called for in claim 9) or a building, which is understood to include houses (as called for in claim 10) since houses are buildings.

5. Claims 1, 2, 6, 8, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Baudard et al. (US 6,765,471).

Referring to claim 1, as shown in the figure, Baudard's communication system comprises (a) identifiers 9 and 10 (i.e., portable devices), each having a communication function (see Col. 2, lines 29-64; Col. 3, lines 39-65; and Col. 4, lines 1-7); (b) central management unit 1 (i.e. a communication controller) that automatically transmits an interrogation signal and receives a response from identifier 9 and/or identifier 10 (i.e., performs mutual communication with identifiers 9 and 10) and controls a door lock driver (i.e., a predetermined driver) in accordance with whether mutual communication with identifier 9 and/or identifier 10 is established (see Col. 2, lines 29-63); (c) a selection device that selects a disablement mode, which disables automatic communication of identifier 9 and/or identifier 10, and a communication mode, which enables automatic communication of identifier 9 and/or identifier 10 (see Col. 2, lines 54-63; Col. 3, lines 2-7 and 48-63; and Col. 4, lines 3-7); (d) a determination unit within each identifier that determines whether to enable or disable automatic communication by recognizing which one of the disablement mode and communication mode the portable device is in (see Col. 2, lines 54-63 and Col. 3, lines 48-63); and (e) a recognition information providing device that provides the determination unit with recognition information used to recognize which one of the disablement mode and communication mode the identifier is in (see Col. 3, lines 48-63 and Col. 4, lines 3-7).

Regarding claim 2, Baudard's identifiers include (a) a selection device that selects a disablement mode upon receiving central management unit 1's inhibit signal and a communication mode upon receiving central management unit 1's activation signal (see Col. 3, lines 53-63 and Col. 4, lines 3-7); and (b) a memory (i.e., a recognition information providing

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device) that provides the determination unit with recognition information, such as a stored inhibit command, used to recognize which one of the disablement mode and communication mode the identifier is in (see Col. 3, lines 48-63 and Col. 4, lines 3-7).

Regarding claim 6, per Baudard, while the identifiers are inhibited (i.e., in the disablement mode), the identifiers are unable to transmit their responses when central management unit 1 transmits an interrogation signal (see Col. 3, lines 53-63); thus each identifier deactivates its transmitting circuit when the identifier is inhibited.

Regarding claims 8 and 9, Baudard's predetermined driver includes a door lock driver that locks and unlocks a door (as called for in claim 8) of a vehicle (as called for in claim 9) (see Col. 2, lines 46-53; Col. 3, lines 2-7 and 53-65; and Col. 4, lines 1-2).

6. Claims 1-7 and 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Ciotta (US 6,856,804).

Referring to claim 1, as shown in Fig. 3, Ciotta's communication system comprises (a) mobile station 10 (i.e., a portable device) having a communication function (see Col. 8, lines 11-29; Col. 9, lines 1-35; and Col. 11, lines 17-21); (b) base station 20, mobile switching center (MSC) 30, home location register (HLR) 40, and database 50 forming a communication controller that automatically performs mutual communication with mobile station 10 and controls remote computer system 60 (i.e., a predetermined driver) in accordance with whether mutual communication with mobile station 10 is established (see Col. 8, lines 24-59; Col. 9, lines 1-15 and 26-55; Col. 10, lines 14-25 and 60-64; and Col. 11, lines 17-21); (c) a selection device at mobile station 10 that enables or disables automatic communication with base station 20 and a selection device at the communication controller that enables or disables automatic communication with mobile station 10 (see Col. 8, lines 11-19 and 24-29; Col. 9, lines 1-15 and 26-35; Col. 10, lines 60-

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64; and Col. 11, lines 14-21); (d) a determination unit at mobile station 10 and at the communication controller that determines whether to enable or disable automatic communication with mobile station 10 by recognizing which one of the disablement mode (i.e., when mobile station 10 is turned off) and communication mode (i.e., when mobile station 10 is turned on) (see Col. 8, lines 11-19 and 24-55; Col. 9, lines 1-15 and 26-55; Col. 10, lines 27-35 and 60-64; and Col. 11, lines 4-9 and 12-21); and (e) a recognition information providing device at mobile station 10 that provides mobile station 10's determination unit with recognition information used to recognize which one of the disablement mode and communication mode mobile station 10 is in (see Col. 8, lines 11-13 and 24-29; and Col. 9, lines 26-30) and a HLR 40 and database 50 forming a recognition information providing device that provides the communication controller's determination unit with recognition information used to recognize which one of the disablement mode and communication mode mobile station 10 is in (see Col. 8, lines 32-45; Col. 9, lines 1-15 and 30-46; Col. 10, lines 27-32 and 60-64; and Col. 11, lines 4-21).

Regarding claims 2 and 3, as explained in the previous rejection of claim 1, Ciotta's mobile station 10 includes a selection device and a recognition information providing device, and Ciotta's communication controller also includes a selection device and a recognition information providing device.

Regarding claim 4, Ciotta's wireless communication system, as shown in Fig. 4, comprises a plurality of mobile stations 10, and the determination unit of Ciotta's communication controller disables automatic communication with respect to each mobile station 10 that is turned off (i.e., in the disablement mode) by routing calls and messages to the disabled mobile stations 10 to voice mail (see Col. 11, lines 4-21).

Regarding claim 5, each of Ciotta's mobile station 10, which is a mobile telephone, has a receiving circuit that receives signals from the communication controller's base station 20 and is deactivated when mobile station 10 is turned off (i.e., in the disablement mode) (see Col. 8, lines 11-19; Col. 9, lines 1-15 and 26-27; Col. 10, lines 60-64; and Col. 11, lines 12-21).

Regarding claim 6, each of Ciotta's mobile station 10, which is a mobile telephone, has a transmitting circuit that transmits signals to the communication controller's base station 20 and is deactivated when mobile station 10 is turned off (i.e., in the disablement mode) (see Col. 8, lines 11-19; Col. 9, lines 1-15 and 21-24; Col. 10, lines 60-64; and Col. 11, lines 12-21).

Regarding claim 7, Ciotta teaches that mobile station 10 transmits a signal indicating when it is turned on or turned off (see Col. 8, lines 11-19 and 24-30; Col. 9, lines 26-35; and Col. 10, lines 14-21). It is understood that mobile station 10's notification device generates the signal indicating that mobile station 10 is turned off (i.e., is in the disablement mode) or turned on (i.e., has shifted from the disablement mode to the communication mode).

Referring to claim 11, Ciotta's method comprises (a) powering off mobile station 10 (i.e., selecting a disablement mode that disables automatic communication with base station 20) and powering on mobile station 10 (i.e., selecting a communication mode that enables automatic communication with base station 20) (see Col. 8, lines 11-10 and 24-35; Col. 9, lines 26-35; Col. 10, lines 60-64; and Col. 11, lines 4-21); (b) transmitting a signal indicating mobile station 10's power-off status or power-on status (i.e., recognition information used to recognize which one of the disablement mode and communication mode) (see Col. 8, lines 11-19 and 24-35; Col. 9, lines 1-15 and 26-35; Col. 10, lines 60-64; and Col. 11, lines 12-21); (c) determining by the communication controller whether mobile station 10 is powered off (i.e., in the disablement mode) or powered on (i.e., in the communication mode) (see Col. 8, lines 11-19 and 24-35; Col. 9,

lines 1-15 and 26-35; Col. 10, lines 60-64; and Col. 11, lines 12-21); and (d) disabling automatic communication to mobile station 10 by routing incoming calls and messages intended for mobile station 10 to voice mail when the communication controller determines that mobile station 10 is powered off (i.e., in the disablement mode) (see Col. 11, lines 12-21).

Regarding claim 12, Ciotta's mobile station 10, which is a mobile telephone, has a receiving circuit that receives signals from the communication controller's base station 20 and is deactivated when mobile station 10 is turned off (i.e., in the disablement mode) (see Col. 8, lines 11-19; Col. 9, lines 1-15 and 26-27; Col. 10, lines 60-64; and Col. 11, lines 12-21).

Regarding claim 13, Ciotta's mobile station 10, which is a mobile telephone, has a transmitting circuit that transmits signals to the communication controller's base station 20 and is deactivated when mobile station 10 is turned off (i.e., in the disablement mode) (see Col. 8, lines 11-19; Col. 9, lines 1-15 and 21-24; Col. 10, lines 60-64; and Col. 11, lines 12-21).

Regarding claim 14, Ciotta's method further comprises (a) generating a signal (i.e., a notice) that mobile station 10 is turned off (see Col. 8, lines 11-19; Col. 9, lines 26-35; and Col. 10, lines 14-21); and (b) generating a signal (i.e., a notice) that mobile station 10 has shifted from being powered off to being powered on (see Col. 8, lines 24-35 and Col. 10, lines 14-21).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clara Yang whose telephone number is (571) 272-3062. The examiner can normally be reached on Tuesdays, 1:00-2:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (571) 272-7308. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CY

12 December 2006


Clara Yang